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LAW OFFICES OF ROBERT J. EICHELBURG
HODAFEL BUILDING, SUITE 200
196 ACTON ROAD
ANNAPOLIS, MD 21403

EXAMINER

TOOMER, CEPHIA D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD LEVY

Appeal 2009-000494
Application 09/359809
Technology Center 1700

Decided: November 30, 2009

Before CHUNG K. PAK, CHARLES F. WARREN, and
PETER F. KRATZ, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 73-100 in the Office Action mailed May 24, 2006. The Examiner has withdrawn several grounds of rejection, leaving claims 73-77, 80-82, 86, 87, 89-93, 96, 96, 99, and 100 for consideration on appeal. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2007).

We reverse the decision of the Primary Examiner.

Claim 73 illustrates Appellant's invention of a lubricating composition, and is representative of the claims on appeal:

73. A process for manufacturing a lubricant composition comprising a polymer where said polymer comprises a superabsorbent polymer that absorbs greater than about 100 times its weight in water, by combining said polymer with a material for lubricating a surface wherein said material for lubricating a surface comprises:

(1) a lubricating metal and alloy thereof, lubricating metal chalcogen compound, halide, carbonate, silicate or phosphate, or a particulate lubricating metal nitride, or a carbon lubricant; or

(2) a silicate ester, polyphenyl ether, organic phosphate, chlorinated biphenyl, phenanthrene, or phthalocyanine compound;

(3) said material for lubricating a surface optionally containing a lubricant comprising an organic lubricant, inorganic lubricant, or a lubricant additive; or

(4) or a mixture thereof.

The Examiner relies upon the evidence in these references:

Obayashi	4,340,706	Jul. 20, 1982
Johnson	5,275,760	Jan, 4, 1994
Takayama	5,792,717	Aug. 11, 1998

Appellant requests review of the following grounds of rejection advanced on appeal by the Examiner (App. Br. ¹10-11):

claims 73, 74, 76, 77, and 90 under 35 U.S.C. § 103(a) over Takayama (Ans. 5); and

claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100, under 35 U.S.C. § 103(a) over Johnson in view of Obayashi (Ans. 6).²

¹ We considered the Appeal Brief filed December 4, 2007, the Supplemental Appeal Brief filed January 11, 2008, the Examiner's Answer mailed April 25, 2008, the Reply Brief filed June 17, 2008, and the Office Communication mailed January 21, 2009 (Office Communication).

Opinion

The dispositive issue in this appeal is the interpretation to be made of the language “wherein said material for lubricating a surface comprises: (1) . . . a lubricating metal . . . carbonate, . . . or a particulate lubricating metal nitride . . .” in representative independent claim 73. In considering the issue, we interpreted the subject language of claim 73 by giving the terms thereof the broadest reasonable interpretation in their ordinary usage in context as they would be understood by one of ordinary skill in the art in light of the written description in the Specification unless another meaning is intended by Appellant as established therein, and without reading into the claim any disclosed limitation or particular embodiment. *See, e.g., In re ICON Health and Fitness, Inc.*, 496 F.3d 1374, 1379 (Fed. Cir. 2007); *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein; *In re Morris*, 127 F.3d 1048, 1054-55 (Fed. Cir. 1997).

The plain language of claim 73 specifies a process for manufacturing a lubricating composition comprising at least the superabsorbent polymer combined with a material for lubricating a surface which comprises at least a lubricating material which must be selected from group (1) and/or group (2). With respect to the ground of rejection over Takayama, the Examiner contends that when the language “a particulate lubricating metal nitride” in group (1) is given its broadest reasonable interpretation, Takayama’s porous ceramic material, the pores of which are filled with a high water absorbing

² The Examiner has withdrawn the following grounds of rejection: all of the grounds of claims 73-100 under the judicially created doctrine of obviousness-type double patenting; claim 89 under 35 U.S.C. § 112, first paragraph. Ans. 3; Office Communication 2.

resin, meets this limitation of claim 73. Ans. 5-6 and 8, citing Takayama, e.g., col. 4, ll. 4-18, 30-32, and 60-62. In the Examiner's view, Takayama forms the ceramic material from particulate boron nitride and the "claims are open to particulate material that may be measured in micrometers as well as particulates that may be measured in millimeters." Ans. 8.

We agree with Appellant that the subject language "a particulate lubricating metal nitride" plainly specifies that a particulate lubricating metal nitride material, which can be boron nitride, is a member of the groupings of lubricating materials at least one of which must be present in the lubricating composition along with the superabsorbent polymer. App. Br. 9-10; Reply Br. 2. We find Takayama sinters ceramic powders having a particle size of preferably no more than 10 μm , including, among other things, boron nitride, which have been shaped by conventional techniques into a desired form. In an illustrative embodiment, "a bearing ring that had an inside diameter of 75 mm and a width of 40 mm" was prepared from silicon carbide. Takayama, e.g., abstract, col. 3, ll. 1-8 and 59-66, col. 4, ll. 4-21, and col. 7, l. 65 to col. 8, l. 6. We know of no authority which defines "particulate" in a manner to include materials of a size measured in millimeters, and the Examiner has cited no authority supporting that position.

Accordingly, we reverse the ground of rejection of claims 73, 74, 76, 77, and 90 under 35 U.S.C. § 103(a) over Takayama.

With respect to the ground of rejection over Johnson and Obayashi, the Examiner contends that Johnson's "alkali or alkaline earth metal carbonate" falls within the claim language in the subject phrase "a

lubricating metal . . . carbonate” of group (1). Ans. 6 and 9, citing Johnson, e.g., col. 4, ll. 44-48. Appellant contends that Johnson does not teach or suggest the use of an inorganic lubricating material. App. Br. 11.

We agree with Appellant. The broadest reasonable interpretation of the subject phrase “a lubricating metal . . . carbonate” is any metal carbonate which acts as a material for lubricating a surface. Appellant discloses and claims lead carbonate as an example of surface lubricating metal carbonate. Spec. 16:25-27, and 24:9-10; *see* claim 77. The Examiner has adduced no evidence or scientific reasoning establishing alkali or alkaline earth metal carbonates as a surface lubricating material falling within claim 73.

Accordingly, we reverse the ground of rejection of claims 73-76, 80-82, 86, 87, 89-93, 96, 99, and 100, under 35 U.S.C. § 103(a) over Johnson in view of Obayashi.

The Primary Examiner’s decision is reversed.

REVERSED

sld

THE LAW OFFICES OF ROBERT J. EICHELBURG
HODAFEL BUILDING, SUITE 200
196 ACTION ROAD
ANNAPOLIS, MD 21403